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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,781	06/11/2001	Alexandra J. Bolton	9000-0055	1484
20855	7590	07/13/2004	EXAMINER	
ROBINS & PASTERNAK 1731 EMBARCADERO ROAD SUITE 230 PALO ALTO, CA 94303			DEVI, SARVAMANGALA J N	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,781

Applicant(s)

BOLTON ET AL.

Examiner

S. Devi, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 51, 62-66, 73 and 76 ~~is/are~~ are pending in the application.
- 4a) Of the above claim(s) 63-66 and 73 ~~is/are~~ are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 51, 62 and 76 ~~is/are~~ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 22504.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO APPLICANTS' AMENDMENT

Applicants' Amendment

- 1) Acknowledgment is made of Applicants' amendment filed 05/17/04 in response to the non-final Office Action mailed 01/07/04.

Status of Claims

- 2) Claims 1, 3-50, 52-61, 67-72, 74, 75 and 77 have been canceled via the amendment filed 05/17/04.

Claims 2, 51, 63, 73 and 76 have been amended via the amendment filed 05/17/04.

Claims 1-77 are pending.

Claims 2, 51, 62-66, 73 and 76 are pending.

Claims 2, 51, 62 and 76 are under examination.

Information Disclosure Statement

- 3) Acknowledgment is made of Applicants' Information Disclosure Statement filed 02/25/04. The information referred to therein has been considered and a signed copy is attached to this Office Action.

Prior Citation of Title 35 Sections

- 4) The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office Action.

Prior Citation of References

- 5) The references cited or used as prior art in support of one or more rejections in the instant Office Action and not included on an attached form PTO-892 or form PTO-1449 have been previously cited and made of record.

Rejection(s) Moot

- 6) The provisional rejection of claims 1, 52 and 53 made in paragraph 7(A) of the Office Action mailed 01/07/04 under 35 U.S.C § 101 as claiming the same invention as that of claims 1, 2, 31, 32, 42 and 56 of the co-pending application 10/134,297, is moot in light of Applicants' cancellation of the claims.
- 7) The rejection of claims 1 and 52 made in paragraph 7(B) of the Office Action mailed 01/07/04 under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claim 2 of the U.S. Patent 6,660,270 ('270) is moot in light of Applicants' cancellation of th claims.

8) The rejection of claim 52 made in paragraph 8 of the Office Action mailed 01/07/04 under 35 U.S.C. § 112, first paragraph, as containing inadequate written description, is moot in light of Applicants' cancellation of th claim.

9) The rejection of claim 52 made in paragraph 9 of the Office Action mailed 01/07/04 under 35 U.S.C § 112, first paragraph, as being non-enabled with regard to the scope, is moot in light of Applicants' cancellation of th claim.

10) The rejection of claims 1, 52 and 53 made in paragraph 11(a) of the Office Action mailed 01/07/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is moot in light of Applicants' cancellation of th claims.

11) The rejection of claim 1 made in paragraph 11(b) of the Office Action mailed 01/07/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is moot in light of Applicants' cancellation of th claim.

12) The rejection of claim 53 made in paragraph 11(d) of the Office Action mailed 01/07/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is moot in light of Applicants' cancellation of the claim.

13) The rejection of claims 1 and 52 made in paragraph 13 of the Office Action mailed 01/07/04 under 35 U.S.C. § 102(b) as being anticipated by Boyle *et al.* (US 5,328,996 - Applicants' IDS), is moot in light of Applicants' cancellation of th claims.

14) The rejection of claims 1 and 52 made in paragraph 14 of the Office Action mailed 01/07/04 under 35 U.S.C. § 102(b) as being anticipated by Choi *et al.* (WO 98/18930 - Applicants' IDS), is moot in light of Applicants' cancellation of th claims.

Rejection(s) Withdrawn

15) The rejection of claim 51 made in paragraph 7(B) of the Office Action mailed 01/07/04 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of the U.S. Patent 6,660,270 ('270) is withdrawn in light of Applicants' amendment to the claim.

16) The rejection of claims 51 and 62 made in paragraph 8 of the Office Action mailed 01/07/04 under 35 U.S.C. § 112, first paragraph, as containing inadequate written description, is withdrawn in

light of Applicants' amendments to the claims.

18) The rejection of claims 51 and 62 made in paragraph 9 of the Office Action mailed 01/07/04 under 35 U.S.C § 112, first paragraph, as being non-enabled with regard to the scope, is withdrawn in light of Applicants' amendments to the claims.

19) The rejection of claims 2, 51 and 53 made in paragraph 11(a) of the Office Action mailed 01/07/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendments to the claims.

20) The rejection of claim 51 made in paragraph 11(b) of the Office Action mailed 01/07/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the claim.

21) The rejection of claim 76 made in paragraph 11(c) of the Office Action mailed 01/07/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendments to the claim.

22) The rejection of claims 2, 52, 53 and 62 made in paragraph 11(d) of the Office Action mailed 01/07/04 under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendments to the claims.

23) The rejection of claims 51 and 62 made in paragraph 13 of the Office Action mailed 01/07/04 under 35 U.S.C. § 102(b) as being anticipated by Boyle *et al.* (US 5,328,996 - Applicants' IDS) is withdrawn in light of Applicants' amendments to the claims.

24) The rejection of claims 51, 62 and 76 made in paragraph 14 of the Office Action mailed 01/07/04 under 35 U.S.C. § 102(b) as being anticipated by Choi *et al.* (WO 98/18930 - Applicants' IDS) is withdrawn in light of Applicants' amendments to the claims.

Rejection(s) Maintained

25) The provisional rejection of claims 2, 51, 62 and 76 made in paragraph 7(A) of the Office Action mailed 01/07/04 under 35 U.S.C § 101 as claiming the same invention as that of claims 1, 2, 31, 32, 42 and 56 of the co-pending application 10/134,297, is maintained for reasons set forth therein. Applicants request that the rejection be held in abeyance until allowable subject matter is indicated

New Rejection(s)

Applicants are asked to note the following new rejection(s) made in this Office. The new rejections are necessitated by Applicants' amendments to the claim(s).

Rejection(s) under 35 U.S.C § 112, Second Paragraph

26) Claims 2, 51, 62 and 76 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant(s) regards as the invention.

(a) Claim 51 lacks proper antecedence in the limitation: 'a GapC protein according to claim 2'. For proper antecedence, it is suggested that Applicants replace the limitation with --the GapC protein according to claim 2--.

(b) Claim 76 lacks proper antecedence in the limitation: 'a GapC protein according to claim 2'. For proper antecedence, it is suggested that Applicants replace the limitation with --the GapC protein according to claim 2--.

Remarks

27) Claims 1, 2, 51-53, 62 and 76 stand rejected.

28) Applicants' amendments necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

29) Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform with the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The RightFax number for submission of before-final amendments is (703) 872-9306. The RightFax number for submission of

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after-final amendments is (703) 872-9307.

30) Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAG or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.Mov>. Should you have questions on access to the Private PAA system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

31) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (571) 272-0854. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (571) 272-0864.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

July, 2004


S. DEVI, PH.D.
PRIMARY EXAMINER